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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,379	01/30/2002	Thomas C. McFarland	100200351-1	4528

7590

05/08/2003

HEWLETT-PACKARD COMPANY
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EXAMINER

PHAM, HAI CHI

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/066,379

Applicant(s)

MCFARLAND ET AL.

Examiner

Hai C Pham

Art Unit

2861

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____ .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The method as recited in each of the claims 33-36 is not understood how the computer-readable media is conceived based on the recited method steps.

Appropriated correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 27, 37, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahle (U.S. 6,074,031).

Kahle, an acknowledged prior art discloses a method and apparatus for printing labels on digital recording media in which the label data is encoded on the digital recording media (col. 5, line 66 to col. 6, line 5), and means for printing (label printer 12) being connected to a driver, which provides a template showing the outline of the label as well as the label formatting and data sorting (col. 5, lines 26-40). Kahle further teaches the use of a personal computer in which the label data is stored in a form of a composite file (HPGL) (col. 6, lines 6-15).

Kahle further teaches:

- input device accepting an input indicating a size of the storage media (the template for outlining the label indicating the size of the storage media) (col. 5, lines 45-55),
- printhead (22) that prints the images on a side of the storage media,
- With regard to claim 27, the label data being encoded on the bottom side of the digital recording media (col. 5, line 66 to col. 6, line 4), and a printhead (22) for printing the label on the upper side of the storage media based on the provided images encoded on the bottom side of the same digital recording media.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 4, 6-10, 12-13, 16-19, 22, 26, 28-32, 38, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('031) in view of Kahle (U.S. 5,518,325).

Kahle ('031) discloses all the basic limitations of the claimed invention except for the laser being used to print the label, printing the images on a label to be affixed onto the storage media, printing a title, which is provided by a user, the label having one side provided with an adhesive for affixing the label onto the storage media.

However, Kahle ('325), another acknowledged prior art, discloses a disk label printing method and apparatus, in which either an ink jet or laser type printer can be used (col. 7, lines 13-14), the images being printed wither directly to the disk (10) or to an attachable label (20) having a self-adhesive on one side to allow the label to be attached to the labeling portion (16) of the disk, the label containing title information of the disk (col. 5, lines 27-38), the images to be printed including artwork (graphic) (col. 6, lines 65-66), and title information, which is provided through a user terminal (32).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Kahle ('031) with the aforementioned teachings of Kahle ('235). The motivation for doing would have been to provide a versatile method of printing a label for an optical storage media compatible with a wide range of printing machine.

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3. Claims 11 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('031) in view of Kahle ('235), as applied to claims 6, 10, 37 above, and further in view of Felleman (U.S. 6,097,503).

Kahle ('031) in view of Kahle ('235) discloses all the basic limitations of the claimed invention except for the composite file being formatted in accordance with a portable document format.

However, it is well known in the art that image data such as text, image, line-art or artwork, for the creation of print product, can be stored in a memory in a composite file in accordance with different file formats that are readable by a computer, such file formats including the postscript (e.g., HPGL) and portable document format languages as evidenced by Felleman at col. 1, lines 16-25.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the image data stored in accordance with the portable document format as taught by Felleman to the modified device of the Kahle ('031) for the purpose of providing image data in a computer-readable format for readily conversion into a printing product.

4. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('031) in view of Kahle ('235), as applied to claim 18 above, and further in view of Tracy (U.S. 5,770,289).

Kahle ('031) in view of Kahle ('235) discloses all the basic limitations of the claimed invention except for the label having grooves that permit portion of the label to be separate from the backing material, the groove having the shape of the disk.

Tracy teaches die cut self-adhesive label sheet for labeling CD-ROMs, the label sheet being provided with a groove that traces the shape of the CD-ROM such that the printing of the entire label is allowed while the label sheet is fed through the printer paper feed mechanism.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the label on a label sheet with groove delimiting the label portion as taught by Tracy in the modified device of Kahle ('031). The motivation for doing so would have been to provide printing of a plurality of labels in a single paper-fed process using the printer paper feed mechanism as indicated by Tracy at col. 2, lines 38-42.

5. Claims 14-15 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('031) in view of Kahle ('235), as applied to claims 6, 18 above, and further in view of Levy (Pub. No. U.S. 2002/0146147 A1).

Kahle ('031) in view of Kahle ('235) discloses all the basic limitations of the claimed invention except for the background printing.

Levy discloses encoded data of watermark to be printed on a label for an optical disk along with the printing the label's background on the label.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Kahle ('031), as modified by Kahle ('235), with the aforementioned teaching of Levy for the purpose of the image of watermark on the label to be easily discerned.

6. Claims 33, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('031) in view of Kahle ('325) and Willis (5,040,003).

Kahle ('031) in view of Kahle ('231) discloses all the basic limitations of the claimed invention except for the computer-readable media.

However, Willis discloses a method for recording color with plural print heads while correcting the misregistration of the print heads by providing a correction program to reduce the cost for mechanical supports needed to accurately register pixels recorded by the respective print heads.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate a correction program as taught by Willis in the device of Corona et al. The motivation for doing so would have been to reduce any cost for mechanical supports needed to accurately printing the title information on the label.

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('031) in view of Kahle ('325) and Willis, as applied to claim 33 above, and further in view of Felleman.

Kahle ('031) in view of Kahle ('325) and Willis, discloses all the basic limitations of the claimed invention except for the composite file being formatted in accordance with a portable document format.

However, it is well known in the art that image data such as text, image, line-art or artwork, for the creation of print product, can be stored in a memory in a composite file in accordance with different file formats that are readable by a computer, such file formats including the postscript (e.g., HPGL) and portable document format languages as evidenced by Felleman at col. 1, lines 16-25.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the image data stored in accordance with the portable document format as taught by Felleman to the modified device of the Kahle ('031) for the purpose of providing image data in a computer-readable format for readily conversion into a printing product.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle ('031) in view of Kahle ('325) and Willis, as applied to claim 33 above, and further in view of Levy.

Kahle ('031) in view of Kahle ('325) and Willis, discloses all the basic limitations of the claimed invention except for the background printing.

Levy discloses encoded data of watermark to be printed on a label for an optical disk along with the printing the label's background on the label.

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It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Kahle ('031), as modified by Kahle ('235) and Willis, with the aforementioned teaching of Levy for the purpose of the image of watermark on the label to be easily discerned.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM
PRIMARY EXAMINER

May 5, 2003